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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,984	09/19/2003	Christopher McGee	020375-042800US	5376
20350	7590	06/07/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			FUREMAN, JARED	
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EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2876	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,984

Applicant(s)

MCGEE ET AL.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/16/2006 has been entered. Claims 1-9, 11, 12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 are pending.

Claim Objections

2. Claims 1, 11, 23, 35 and 36 are objected to because of the following informalities:

Claim 1, line 8: "the" (first occurrence) should be deleted and "edge" should be replaced with --edges--, in order to avoid a lack of proper antecedent basis for "the outside edge".

Claim 11, lines 1-2: Claim 11 recites, "... wherein the data card has a circular shape." However, claim 1 (from which claim 11 depends), lines 5-6, recites, "... wherein the data card comprises a rectangular shape having dimensions that are about 2 1/8 inches by about 3 3/8 inches ...". It is unclear as to how the card could have a circular shape, as recited in claim 11, and a rectangular shape having the dimensions

as recited in claim 1. For examination purposes, claim 11 has been interpreted to require a data card having a rectangular shape as recited in claim 1.

Claim 23, line 8: "the" (first occurrence) should be deleted and "edge" should be replaced with --edges--, in order to avoid a lack of proper antecedent basis for "the outside edge".

Claim 35, line 7: "the" (first occurrence) should be deleted and "edge" should be replaced with --edges--, in order to avoid a lack of proper antecedent basis for "the outside edge".

Claim 36:

Line 7, "the" should be deleted and, line 8, "edge" should be replaced with --edges--, in order to avoid a lack of proper antecedent basis for "the outside edge".

Line 9, "." should be replaced with --;--, to correct a typographical error.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 67 and 74-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 67, the original disclosure does not teach the specific dimensions of the protrusion, that is "extending no more than about 1/2 of an inch and at least 1/8 of an inch away from the top edge", as recited in lines 6-7, of claim 67. It is noted that these limitations were added to claim 67 in the amendment dated July 15, 2005.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 31, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Blank (US 7,032,817).

Blank teaches a financial presentation instrument (transaction card assembly 1, figure 4) with an integrated holder comprising: a data card having a circular shaped portion (the auxiliary portion 20 in figure 4) and a rectangular shaped bottom portion (the card portion 10 in figure 4) having an information storage medium (while not shown in figure 4, Blank teaches that the card portion 10 includes an information storage media, see column 2, lines 12-15; column 5, lines 38-44; column 6, lines 34-41; and

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column 7, lines 20-25) that is configured to store a unique identifier (a credit card number and/or account number, see column 6, lines 34-41, will be a unique identifier) and at least one centrally spaced aperture (figure 4 shows the card assembly 1 having an aperture centrally spaced in auxiliary portion 20) therethrough for suspending the data card from a display hook (the aperture, as shown in figure 4, is clearly capable of suspending the data card from a display hook, therefore this functional limitation does not structurally define applicant's invention over Blank), wherein the rectangular shaped bottom portion has the information storage medium displayed thereon (see column 2, lines 12-15; column 6, lines 34-41; and column 7, lines 20-25) and the diameter of the circular shaped portion is less than a longest length of the rectangular shaped bottom portion (see figure 4); wherein the data card comprises a stored value card (see column 2, lines 47-49); wherein the data card comprises a gift card (see column 2, lines 47-49) (also see column 1, lines 18-20; column 2, lines 12-15, 47-53; column 5, lines 38-45, 55-63; column 6, lines 34-41; column 7, lines 20-25; and column 8, lines 32-41).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 23, 24, 26, 28-30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yen (US 2002/0066789 A1, previously cited) in view of Silverbrook et al (US 2003/0086705 A1).

Re claims 23, 24, 26, 28, 29 and 35: Yen teaches a financial presentation instrument with an integrated holder comprising: a rectangular shaped data card (substrate 10, figures 1-5) having an information storage medium (value added chip 15, figure 3; magnetic strip 16, figure 4; bar code 17, figure 5; for example) that is configured to store a unique identifier (a credit card, personal identification card, or bank card, see paragraph 22, will store a unique identifier) and at least one aperture (central hole 11, figure 1 and paragraph 17) therethrough for suspending the data card from a display hook (the central hole 11, as shown in figures 1-4, is clearly capable of suspending the data card from a display hook, therefore this functional limitation does not structurally define applicant's invention over Yen), wherein the at least one aperture is located on a central portion of the data card (see central hole 11, figures 1-5), wherein the data card further comprises a back side with the information storage

medium located thereon (the side shown in figures 3-5 can be considered a back side), a front side (the side shown in figure 1 can be considered a front side), and the aperture (central hole 11) is at least $1/16$ of an inch from outside edges of the card and the information storage medium (see figures 1-5); wherein the aperture comprises a circular shape (the central hole 11 is circular, see figures 1-5); wherein the data card comprises a stored value card (a telephone card, public transportation ticket, bank card, etc., represented a stored value, see paragraphs 21 and 22); wherein the information storage medium comprises a magnetic stripe (magnetic strip 16, figure 4 and paragraph 22); wherein the information storage medium comprises a bar code (bar code 17, figure 5 and paragraph 23); (also see figures 1-5, paragraphs 7, 16, 17, 19-24).

Yen fails to specifically teach a live copy limit that is about $3/32$ of an inch from outside edges of the card; the aperture being at least $1/16$ of an inch from the live copy limit.

Silverbrook et al teaches a data card (figure 1) including a front side (data surface 101) comprising a live copy limit (border region 103) that is about $3/32$ of an inch (2.5mm margins is about $3/32$ of an inch) from outside edges of the card (see figure 1 and paragraph 67).

In view of Silverbrook et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen, a live copy limit that is about $3/32$ of an inch from outside edges of the card; the aperture being at least $1/16$ of an inch from the live copy limit; in order to

provide a border that can be used by an encoded data reader to calibrate signal levels, thereby allowing accurate reading of the encoded data.

Re claim 30: The teachings of Yen as modified by Silverbrook et al have been discussed above. Yen also teaches that the data card comprises a credit card (see paragraph 22).

Yen fails to specifically state wherein the card has dimensions that are about 2 1/8 inches by about 3 3/8 inches.

However, at the time of the invention it was old and well known to those of ordinary skill in the art that a standard credit card has dimensions that are about 2 1/8 inches by about 3 3/8 inches.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Silverbrook et al, wherein the card has dimensions that are about 2 1/8 inches by about 3 3/8 inches; in order for the card to be compatible with standard credit card readers, thereby eliminating the need for a specialized credit card reader and the inherent costs associated therewith.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yen as modified by Silverbrook et al and further in view of Duroj (US 2002/0006103 A1, previously cited).

The teachings of Yen as modified by Silverbrook et al have been discussed above.

Yen as modified by Silverbrook et al fails to specifically teach an additional aperture through the data card.

Duroj teaches a data card (card 1, figure 1) comprising an aperture (3, figures 1-3) located on a central portion of the data card and an additional aperture (8, figure 3) through the data card (see figures 1-3, paragraphs 7, 12, 13, 18 and 20).

In view of Duroj's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Silverbrook et al, an additional aperture through the data card; in order to allow the data card to be attached to a carrying device or the like (see paragraph 20, of Duroj).

10. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yen as modified by Silverbrook et al and further in view of the admitted prior art.

The teachings of Yen as modified by Silverbrook et al have been discussed above.

Yen as modified by Silverbrook et al fails to specifically teach wherein the data card comprises a gift card.

The admitted prior art teaches that gift cards were old and well known to those of ordinary skill in the art at the time of the invention (see paragraph 2 of applicant's specification).

In view of the admitted prior art, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Silverbrook et al, wherein the data card comprises a gift card; in order to increase demand and sales of the data card by allowing the data card to function as a gift card. Furthermore, the data card comprising a gift card represents an intended use of the data card, which fails to structurally define applicant's invention over Yen as modified by Silverbrook et al (for example, the structure of Yen is capable of functioning as a gift card).

11. Claims 1-9, 11, 12, 15-20, 36, 41-50, 67 and 74-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yen as modified by Silverbrook et al and further in view of Biller (US 2004/0182940 A1, previously cited).

Re claims 1, 3-9, 11, 12, 15-20, 36, 41, 42, 45-50, 67 and 74-78: The teachings of Yen as modified by Silverbrook et al have been discussed above. Yen also teaches the data card (substrate 10) comprising top and bottom flat portions and two side flat portions (see figures 1-5); regarding the claimed 3 3/8 inches long by 2 1/8 inches long, see Yen as modified by Silverbrook et al as applied to claim 30 above; wherein the data card has a circular shape (in as much as a data card that is claimed to be rectangular, as recited in claim 1, can have a circular shape as recited in claim 11). Note that in applying Yen as modified by Silverbrook et al to claims 12-16, the central hole 11 can be considered an additional aperture, the additional aperture being circular.

Yen as modified by Silverbrook et al fails to specifically teach at least one J-peg shaped aperture; an additional aperture through the data card; wherein the data card comprises a gift card; a method for displaying a financial presentation instrument with an integrated holder comprising: providing a display hook and suspending the data card from the display hook through the at least one aperture; wherein the aperture is located on a top portion of the data card; wherein the aperture is located on a side portion of the data card; a protrusion extending no more than about $\frac{1}{2}$ of an inch and at least $\frac{1}{8}$ of an inch away from the top edge, at least one aperture through the protrusion.

Biller teaches a data card (120, figure 3) comprising a J-peg shaped aperture (display hole 80, figure 3) therethrough for suspending the data card from a display hook (not shown, see paragraph 38); wherein the data card comprises a gift card (see paragraphs 2 and 5); and a method for displaying a financial presentation instrument with an integrated holder comprising: providing a display hook (not shown) and suspending the data card from the display hook through the at least one aperture (see paragraph 38); wherein the aperture is located on a top portion of the data card (see figure 3); wherein the aperture is located on a side portion of the data card (the top of the card is also one of the sides of the card, see figure 3); a protrusion extending no more than about $\frac{1}{2}$ of an inch and at least $\frac{1}{8}$ of an inch away from the top edge (In figure 3 of Biller et al, the disc 120 can be considered as having a top flat edge with a protrusion extending from the top flat edge, like applicant's figure 10K. While Biller et al does not specifically teach extending no more than $\frac{1}{2}$ of an inch and at least $\frac{1}{8}$ of an inch, it is believed that figure 3 suggests this to one of ordinary skill in the art at the time

of the invention), at least one aperture (80) through the protrusion (compare Biller et al's figure 3 to applicant's figure 10K).

In view of Biller's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Silverbrook, at least one J-peg shaped aperture; an additional aperture through the data card; wherein the data card comprises a gift card; a method for displaying a financial presentation instrument with an integrated holder comprising: providing a display hook and suspending the data card from the display hook through the at least one aperture; wherein the aperture is located on a top portion of the data card; wherein the aperture is located on a side portion of the data card; a protrusion extending no more than about $\frac{1}{2}$ of an inch and at least $\frac{1}{8}$ of an inch away from the top edge, at least one aperture through the protrusion; in order to allow a more stable mounting of the data card, using the J-peg shape, on display hooks.

Re claims 2, 43 and 44: The teachings of Yen as modified by Silverbrook et al and Biller have been discussed above. Biller also teaches the aperture located on a top portion of the data card.

Yen as modified by Silverbrook et al and Biller fails to specifically teach providing an additional display hook and suspending the data card from the additional display hook through the additional aperture; wherein the pair of apertures are located on a top portion of the data card.

However, at the time of the invention it was old and well known to those of ordinary skill in the art to display retail products by hanging the products from two (or more) display hooks through corresponding apertures.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card and method as taught by Yen as modified by Silverbrook et al and Biller, providing an additional display hook and suspending the data card from the additional display hook through the additional aperture; wherein the pair of apertures are located on a top portion of the data card; in order to provide a more stable mounting of the data card to the display.

Response to Arguments

12. Applicant's arguments with respect to claims 1-12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 have been considered but are moot in view of the new ground(s) of rejection. As discussed above, Yen, Duroj and Blank teach a data cards having an aperture, and Silverbrook et al teaches a data card including a live copy limit.

In addition, applicants are reminded that functional language (for example, "for suspending the data card from a display hook", as recited in independent claims 1, 12, 23, 31, 35 and 67) does not define the invention over the prior art, when the prior art discloses the claimed structural limitations and is capable of performing the recited function (see MPEP 2114). In this case, the apertures of Yen, Duroj and Blank are capable of suspending the data card from a display hook.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith (US 7,000,844) and Diaz et al (US D512,456 S) both teach data cards and holders. Fujimoto (US 2004/0080784) teaches leaving a border when printing an IC card (see figures 14 and 15). Jung (US 4,804,827) teaches an ID card having a border 8. Chandaria (US 2004/0040189 A1) and Krahn (US 6,145,665) are cited as evidence that it was old and well known to those of ordinary skill in the art at the time of the invention to include multiple apertures and display hooks (see figure 5 of Chandaria and column 3, lines 15-16 of Krahn).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Jared J. Fureman
Jared J. Fureman
Primary Examiner
Art Unit 2876

May 26, 2006